

Remarks and Arguments

Applicants wish to thank the Examiner for the courtesy of a telephone discussion on March 23, 2007, regarding the examined claims.

Claims 1-33 were pending in this case. Claims 1, 5, 6, 8, 9, 13-16, 22, 24, and 27-31 have been amended. Claims 10-12, 17, 32, and 33 have been cancelled. No new claims have been added. Accordingly, claims 1-9, 13-16, and 18-31 remain for examination.

Rejections Under 35 U.S.C. § 112, ¶ 1

Written Description

Claims 13, 15, 20-23, 32, and 33 are rejected under 35 U.S.C. § 112 first paragraph as allegedly failing to comply with the written description requirement. Applicants respectfully traverse this rejection in view of the following remarks and amendments.

The Examiner asserts that the Vitamin E derivatives of claims 13 and 15 do not have support in the specification. Applicants respectfully disagree and note that the specification at p. 19, ll. 29-30 describes the claimed Vitamin E derivatives.

The Examiner asserts that claims 20-23, relating to surface area enhancing features, are not supported by the original description. Applicants respectfully disagree and note that such surface area enhancing features are described at p. 23, ll. 27-30.

The Examiner asserts that claims 32 and 33, reciting three layers where two layers comprise different biologically active agents, have no support in the original specification. Applicants respectfully disagree and note that the application incorporates by reference parent U.S. Application No. 09/991,234, which describes layered materials where one or more layers can have different biologically active agents. However, for the sole purpose of expediting prosecution, claims 32 and 33 have been cancelled.

Accordingly, Applicants respectfully submit that claims satisfy the written description requirement and respectfully request withdrawal of this rejection.

Enablement

Claims 13 and 15 are rejected under 35 U.S.C. § 112, first paragraph as being nonenabling for all derivatives of vitamin E. Applicants respectfully disagree. The enablement standard is quoted below:

The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

United States v. Telectronics, Inc., 857 F.2d 778, 785 (Fed. Cir. 1988).

It appears that this rejection was made because the specification fails to list a sufficient number of specific vitamin E derivatives. Applicants respectfully submit that the enablement requirement "is separate and distinct from the description requirement." (MPEP § 2164.) The "purpose of the 'written description' requirement is broader than to merely explain how to 'make and use.'" (*Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991); MPEP § 2164.)

Applicants respectfully submit that the specification adequately describes how to make and use coating of vitamin E. In light of these teachings, those skilled in the art can make and use a coating without undue experimentation of various vitamin E derivatives having a melting point of 50°C or less. Vitamin E derivatives are well known and can be located in many chemical catalogs. A listing in the specification is not necessary as a "patent need not teach, and preferably omits, what is well known in the art." (MPEP § 2164.)

Claim 23 is rejected under 35 U.S.C. § 112, first paragraph as being nonenabling for "at least some" coating, in light of the specification allegedly describing the coating as "completely encapsulating" the structure at page 13, lines 29-30.

Applicants first note that a typographical error of the citation "page 13, lines 29-30" seems to have been made as the quoted phrase "completely encapsulating" is not present on this page, or in any page of the specification.

Applicants respectfully submit that the specification does enable this limitation at p. 19, ll. 23-26. Here, the specification describes a liquid that adheres to "at least a

portion" of the stent. In light of this description and the knowledge of one skilled in the art, a stent having surface enhancing features containing at least some of the coating composition would not present a task of undue experimentation.

Accordingly, Applicants respectfully submit that claims 13, 15, and 23 are enabled and respectfully request withdrawal of this rejection.

Double Patenting Rejection

Claims 1-33 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-41 of copending U.S. Application No. 10/446,916 ("US'916). Applicants note that according to the U.S.P.T.O database at Public PAIR, claims 1-41 of US '916 have been cancelled and thus, this rejection is moot. Accordingly, Applicants respectfully request withdrawal of this rejection.

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending U.S. Application No. 11/397,778 ("US '778). Without acquiescing in the rejection, Applicants respectfully request abeyance of this rejection until the scope of the allowed claims and the claim of US '778 has been established.

Rejection Under 35 U.S.C. § 102

Claims 1, 3-11, 17-19, 24, and 27-33 are rejected under 35 U.S.C. § 102(b) as being anticipated by EP 0 734 721 ("EP '721"). The Examiner asserts that EP '721 suggests a coating for stents including biodegradable polymers.

Without acquiescing in the rejection, and for the sole purpose of expediting prosecution, Applicant has amended independent claims 1, 5, 6, 24, and 27-31 to recite a coating composition comprising a nonpolymeric carrier component. EP '721 in contrast does not disclose, teach, or suggest a nonpolymeric carrier component.

Accordingly, Applicants respectfully request that EP '721 does not anticipate claims 1, 3-11, 17-19, 24, and 27-33 and respectfully request withdrawal of this rejection.

Conclusion

The amendments to the claims, as set forth herein, including the addition or cancellation of any claims, have been offered to advance this application to issue. None of the amendments made herein should be construed as an admission that the subject matter of the claims, as originally filed, is anticipated by or made obvious in light of any art of record whether considered singularly or in combination. Applicant respectfully reserves the right to pursue the originally filed claims in another co-pending application without being prejudiced by any amendments, including cancellation of claims, made herein.

Applicant believes all claims are in allowable condition. A notice of allowance for this application is earnestly solicited. If the Examiner has any questions regarding this amendment, the Examiner is invited to call Applicant's attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §§1.16 and 1.17 to Deposit Account No. 02-3038.

Respectfully submitted,

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